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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

D.L. BEASLEY et al.

EXAMINER: D. Dinh

SERIAL NO. 08/969,723

FILED: November 12, 1997

GROUP ART: 2757

Received
FEB 17 1999
Group 2700

FOR: CIRCUIT FOR PRODUCING OVERLAID VIDEO SIGNALS

OPPOSITION TO PETITION TO WAIVE THE RULES
AND PROTEST UNDER 37 CFR 1.291

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

Apex PC Solutions, Inc., the assignee of the above-identified patent application, opposes (1) the Petition to Waive the Rule and (2) the Protest under 37 CFR 1.291 filed by Cybex Computer Products Corporation. The Petition and Protest analogize the present situation to Harley v. Lehman, 981 F. Supp. 9 (D.C. 1997), but the facts are completely distinguishable. As quoted in Cybex's Petition, the Petition in Harley was granted "because new art had been submitted in a Protest."¹ Attempting to parallel Harley, Cybex states that:

The present petition is filed because the Examiner and Group Director should be allowed to fully consider the applicability of prior art U.S. Patent No. 5,732,212 (hereafter "the '212 patent") to the claims of the pending Beasley Application.²

Noted
3/25/99

¹Id. at 10.

²Petition page 3 lines 17-20.

However, as evidenced by the attached Supplemental Notice of Allowability and IDS, the examiner already considered the '212 patent on December 4, 1998. Thus, the examiner has already "consider[ed] the applicability of ... the '212 patent," and the present application need not be withdrawn for that reason.

What Cybex has actually filed is a veiled Request for Reexamination Under 37 CFR 1.510, but prior to issuance of the patent. However, even if Cybex waited for the patent to issue, it would not be entitled to obtain reexamination of the patent based on the '212 patent. 37 CFR 1.510(b)(1) requires that a Request for Reexamination include "A statement pointing out each substantial new question of patentability based on prior patents and printed publications."³ Since the examiner has already considered the '212 patent, there is no substantial new question of patentability.

Moreover, it would be inequitable to punish Apex for Cybex's delay in filing. Cybex has known of the existence of the '212 patent for a considerable amount of time. Cybex could have complied with the requirement of 37 CFR § 1.291(a), requiring that a "protest specifically identify[] the application to which the protest is directed," by filing a request identifying "any continuation-in-part, or reissue application claiming priority to application Serial No. 519,193, filed August 25, 1995." Instead, Cybex chose to wait and now disingenuously argues that "strict confidentiality rules"⁴ prevented an earlier filing.

Cybex is represented by counsel who could have used the publicly available serial number of the parent application as the basis for a protest. In fact, they have now adopted the appropriate language, stating that:

³Emphasis supplied.

⁴Petition page 5 line 12.

a Protest is hereby lodged against grant of a patent on U.S.
Application Serial No. 08/969,723, filed November 12, 1997...,
and against the grant of a patent on any continuation and/or
divisional of that application, or its parent application.⁵

Accordingly, the Petition and Protest should be denied as the cited reference raises no
new substantial question of patentability and is simply designed to harass the assignee of the
above-identified patent application.

Respectfully submitted,



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⁵Protest page 1 paragraph 1; emphasis supplied.

CERTIFICATE OF SERVICE

This is to certify that one copy of the foregoing document is being sent by next-business-day courier service to H. Warren Burnam, Jr., Nixon & Vanderhye P.C., 1100 North Glebe Road, 8th Floor, Arlington, VA 22201-4714, attorney for the party Cybex Computer Products Corporation, as identified in the Petition and Protest.

Dated: 17 Feb 99



Charles L. Gholz